UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
ALTSCHUL, AMBER L

ART UNIT	PAPER NUMBER
3686	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/476,415	SANDBERG, DALE
	Examiner	Art Unit
	AMBER L. ALTSCHUL	3686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>23 July 2009</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>21,23-29,32,42 and 43</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>21, 23-29, 32, and 42-43</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)
1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____ .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on July 23, 2009 has been entered.

Response to Amendment

2.   This communication is in response to the amendment filed on July 23, 2009. Claims 21,

23-29, 32, and 42-43 have been presented for examination. Claims 21, 24-25, and 42-43 have

been amended. Claims 22 and 42-55 have been cancelled.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

4.   Claims 21, 23-29, 32, and 42-43 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Evans (5,924,074) in view of Feldon et al. (5,732,221), Lavin et al.

(5,772,585), Provost et al. (6,341,265), and Lancelot et al. (6,434,531).

(A) (currently amended) As per claims 21, 24-25, and 32, Evans discloses a medical records

method and system for storage and retrieval of dynamic electronic medical records in a computer

environment, such as a local or wide area network including portable computers (col. 1 lines 5-

10), wherein patient data, such as patient complaints, lab orders, medications, diagnoses, and

procedures, are captured at the point of care of a patient in real-time, such as during an

examination or in hospital (see Figure 24), using a graphical user interface having touch screens

in a point of care system (Abstract; lines 1-5; col. 2 lines 20-64, col. 5 lines 29-55, and col. 5

lines 8-10), comprising:

        (a) selecting a procedure from a list of procedures administered by a physician of a

healthcare facility, wherein the procedures reflect treatments of a physician, and wherein the

procedures are included in a form, wherein the healthcare procedures are limited to reflect only

the medical services rendered by the individual healthcare provider (Figures 20, 24, col. 6 line 10

to col. 11 line 40, col. 11 lines 9-64);

        (b) selecting a diagnosis from a list of diagnoses made by a physician of a healthcare

facility, wherein the diagnosis indicates the proper administration of procedures to be performed

by a physician, and wherein the diagnoses are included in a form, the diagnosis and the

procedure being limited to reflect only those commonly rendered by the individual healthcare

provider (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64);

(c) activating the form for use by a health care provider when diagnosing and performing a procedure or administering a treatment on a patient (Figures 1,5-6, 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64);

(d) determining a particular sequence of the pool of healthcare procedures based upon user preferences (Figure 20, the doctor can select the sequence of the procedures displayed on the form);

(e) using the form to select a procedure, wherein the procedures reflect treatments of a physician, and wherein the procedures are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64) and to select a diagnosis from a list of diagnoses made by a physician of a healthcare facility, wherein the diagnosis indicates the proper administration of procedures to be performed by a physician, and wherein the diagnoses are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64).

Evans fails to expressly recite a "customizable form".

Feldon discloses entering a patient's demographic information, medical history, prescribed medication and other relevant information for a patient, including information a physician documents during the exam using exam descriptors, into data entry forms, wherein a user is able to customize these data entry forms by editing existing forms or by redesigning completely new forms, wherein the form is able to be saved using a computer, or emulates a printed data form of which the individual healthcare provider is accus (Figure 1, col. 4 lines 13-63, col. 8 lines 62-67, and col. 9 lines 15-65, col. 11 lines 1-58, and col. 12 lines 1-9).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include the aforementioned features of Feldon within the method of Evans with the motivation of allowing forms to be generated based on the user's needs and customized for the particular task at hand (Feldon; col. 4 lines 52-54) and transforming a patient chart from a static record of a few clinical interactions into a dynamic, real-time comprehensive record (Evans; col. 2 lines 34-40).

Evans and Feldon fail to expressly disclose patients wherein the step for generating the customizable form comprises: defining display specifications that relate to i) a display of the healthcare procedures characteristically performed by the particular healthcare provider and (ii) a display of the healthcare diagnoses characteristically performed by the particular healthcare provider, and wherein the display specifications are based on individual user preference.

Lavin discloses creating a customized list for a health care provider's practice specialty, wherein the customized list relates to diagnoses and procedures used in the specialty (reads on "a display of the healthcare procedures characteristically performed by the particular healthcare provider" and "a display of the healthcare diagnoses characteristically performed by the particular healthcare provider, and wherein the display specifications are based on individual user preference") (Figure 13, col. 9 lines 29-40). Further, Lavin discloses creating and viewing the customized list in a graphical user interface (reads on "customizable form") (Fig. 17, col. 3 line 65 to col. 4 line 17, col. 13 lines 28-59).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Lavin within the method taught collectively by Evans and

Feldon with the motivation of maximizing the efficiency and effective use of the physician's

time (col. 15 lines 46-59) by providing customized lists created for a particular physician's

practice specialty (Fig. 13).

Evans, Feldon, and Lavin fail to expressly disclose using the customizable form to

display billing information prior to the rendering of the one of the procedures on the patient to

allow the healthcare provider to advise the patient as to healthcare service to be rendered,

including the most cost efficient healthcare alternative for the patient, and wherein the step for

using the customizable to display billing information is performed during an examination of the

patient, and wherein the step for using the customizable form to display billing information

includes allowing the healthcare provider to selectively adjust the cost of rendering the one of the

procedures at the time of the examination of the patient.

Provost discloses a claim form for entering patient information, including insurance plan

information, diagnosis codes, treatment codes, wherein the dollar amounts for a treatment code

are displayed, wherein the dollar amounts can be displayed in a short amount of time which is

limited by data transmission rates, wherein the patient is able to present because the dollar

amounts can be collected from the patient in the office, wherein the physician may provide

alternative treatments which are approved for payment by an insurance plan (Abstract, Fig. 3,

4A, 4B, col. 8 line 32 to col. 12 line 14).

At the time the invention was made, it would have been obvious to one of ordinary skill

in the art to combine the teachings of Provost within the method taught collectively by Evans,

Feldon, and Lavin with the motivation of reducing the number of insurance claims that are

rejected by an insurance company (Provost; col. 2 lines 27-57) and decreasing the amount of time to determine whether a claim will be paid (Provost; col. 2 lines 27-57).

Evans, Feldon, Lavin, and Provost fails to expressly disclose:

using a computer interface to define a new structure for the customizable form that is not generated from a printed data form, selecting a number of rows for inclusion into the customizable form, defining specifications relating to the pool of healthcare procedures and to the one or more healthcare diagnoses, and displaying the customizable form in a definition window.

Lancelot discloses using a computer interface to define a new structure for the customizable form that is not generated from a printed data form (Fig. 4, 6, 11, col. 9 line 64 to col. 11 line 7, col. 12 lines 7-15, col. 15 line 35 to col. 16 line 6), selecting a number of rows for inclusion into the customizable form (Fig. 4, 6, 11, col. 9 line 64 to col. 11 line 7, col. 12 lines 7-15, col. 15 line 35 to col. 16 line 6), defining specifications relating to the pool of healthcare procedures and to the one or more healthcare diagnoses (Fig. 4, 6 col. 10 lines 14-21, col. 15 line 35 to col. 16 line 6), and displaying the customizable form in a definition window (Fig. 4, 6, 11, col. 9 line 64 to col. 11 line 7, col. 12 lines 7-15, col. 15 line 35 to col. 16 line 6).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Lancelot within the method taught collectively by Evans, Feldon, Lavin, and Provost with the motivation of allowing for the tailoring of templates (or forms) based on the requirements for a given patient (Lancelot; col. 1 lines 53-60).

Automatically recording an insurance code entry on an insurance invoice, the insurance

code entry representing the diagnosis and the procedure selected by the specialized healthcare

provider, wherein the process of selecting the diagnosis and the procedure automatically creates

the insurance code entry on the insurance invoice, (See Evans Abstract; lines 1-5; col. 2 lines

20-64, col. 5 lines 29-55, and col. 5 lines 8-10).

(B) (previously presented) As per claim 23, Evans discloses a data interface permitting

communication with external sources to obtain patient data and to transfer patient information to

external health care providers, such as demographic data, laboratory test results, x-ray images,

ICD9 diagnosis codes and CPT procedure codes, prescriptions for medications (col. 9 lines 1-

14). The remainder of claim 23 repeats the same limitations as claim 21, and is therefore

rejected for the same reasons given for claim 21, and incorporated herein. It is noted that the

step of transferring patient information, including ICD9 diagnosis codes and CPT procedure

codes, to external health care providers (col. 9 lines 1-14) is considered to be a form of "one or

more other healthcare procedures or diagnoses used by another healthcare provider of a

healthcare facility" as recited in claim 23.

(C) (Previously Presented) As per claim 26, Feldon discloses customizing data entry forms for a

physician, for example for an examination of the eye by defining common types of eye exams

(col. 1 line 20 to col. 2 line 12 and col. 4 lines 30-45). The remainder of claim 26 repeats the

same limitations as claim 21, and is therefore rejected for the same reasons given for claim 21,

and incorporated herein. The motivation for combining Feldon within Evans is given above in

claim 21, and is incorporated herein.

(D) (Previously presented) As per claim 27-29, Evans discloses entering and updating a patient record using a form, wherein the patient record includes insurance information, ICD9 diagnosis codes and CPT procedure codes, wherein upon entering and updating information, the electronic medical record system filed the patient's record in real-time in the patient data repository (Abstract, lines 1-2; Fig. 2-3, 5-6, and 14, col. 5 lines 1-27, col. 6 line 55 to col. 7 line 5, col. 9 lines 1-14).

It is noted that Evan's discloses recording insurance information as well as diagnosis and procedure codes within a patient record as discussed above (Abstract, lines 1-2; Fig. 2-3, 5-6, and 14, col. 5 lines 1-27, col. 6 line 55 to col. 7 line 5, col. 9 lines 1-14). As this information is most frequently used for billing purposes (i.e., billing insurance companies), it is respectfully submitted that this information within the patient record is a form of a "billing record." Furthermore, as per the recitation of "the billing record corresponding to standards in the industry," it is noted that ICD9 codes and CPT codes are widely accepted codes used to report and index medical records and are considered to be the standard codes set for reporting health care services in electronic data transactions.

(E) (currently amended) Claims 42-43 repeat the limitations of claims 21 and 33, and are therefore rejected for the same reasons as those claims.

Response to Arguments

5.   Applicant's arguments filed July 23, 2009 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed July 23, 2009.

(A)   At pages 10-13 of the July 23, 2009 response, Applicant argues that none of the references cited, alone or in combination, teaches or suggest the limitations for using a computer interface to define a new structure for a customized form that emulates a printed data form of which the individual healthcare provider is accustomed to using and for limiting diagnoses and procedures to reflect only those commonly rendered by the individual healthcare provider. In response, the Examiner respectfully disagrees. It is readily apparent that Evans in view of Feldon, Lavin, Provost and Lancelot teaches these aforementioned limitations, (See Office Action Above). Therefore, examiner maintains rejections detailed in the previous office action.

(B)   Applicant's remaining arguments in the response filed July 23, 2009 rely on or re-hash the issues addressed above or in previous Office Actions and therefore, are moot in view of the responses given above and incorporated herein.

6.   Applicant's arguments with respect to claims 21, 23-29, 32, 42-43 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amber L. Altschul whose telephone number is (571) 270-1362. The examiner can normally be reached on M-Th 7:30-5, F 7:30-4, every other Friday off.

9.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gerald J. O'Connor can be reached at (571) 272-6787. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300.

10.   Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-8219.

11.   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

would like assistance from a USPTO Customer Service Representative or access to the

automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/A. L. A./
Examiner, Art Unit 3686
September 10, 2009

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686